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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/536,567

Filing Date: May 26, 2005

Appellant(s): SANDER, ULRICH

George L. Snyder, Jr (Reg. No. 37,729)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/20/2008 appealing from the Office action mailed 10/25/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct

(8) Evidence Relied Upon

US 2001/0010592	NAKAMURA	8-2001
US 5,898,518	BIBER	4-1999
US 5,052,789	KLEINBERG	10-1991
US 4,640,588	TANAKA	2-1987
US 5,528,426	HOWES	6-1996
US 6,421,173	CORBISIERO ET AL.	7-2002
US 4,763,968	MINAMI ET AL.	8-1988
DE 1 217 099	LITTMAN	5-1966

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (US Patent Application Publication No. 2001/0010592) in view of Biber (US Patent No. 5,898,518).

With respect to claim 14, Nakamura discloses an apparatus comprising: a main microscope (1) including a main objective (21) having an optical axis (K1), a pair of main stereoscopic observation beam paths passing through the main objective (21), and a zoom (22) in the main observation beam paths, the zoom having an axis arranged at an angle to the optical axis (K1) of the main objective (21); an assistant's microscope (26); and a beam splitter (B1) arranged in the main observation beam paths before the main objective (21) and the zoom (22) for reflecting out a pair of assistant's stereoscopic observation beam paths to the assistant's microscope; wherein the beam splitter (B1) is continuously rotatable, together with the assistant's microscope (26), relative to main microscope (1) about the optical axis (K1) of the main objective (21), whereby the beam splitter (B1) and assistant's microscope (26) are optically usable in any rotational position (figs. 1-5). Nakamura does not expressly disclose the beam splitter arranged between the main objective and the zoom. However, Biber discloses a similar stereomicroscope with an assistant's microscope (37) attached wherein the assistant's microscope (37) is disposed between the main microscope (38) (including a zoom system) and the main objective (30) (fig. 3a) and teaches that the desirability of this arrangement so that an assistant can adjust the illumination system for the main observer and vice versa (col. 1, lines 51-65). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to arrange the beam splitter of Nakamura between the main objective and zoom

system for the advantages taught by Biber (col. 1, lines 51-65) and/or to reduce the number of parts (i.e. multiple objectives) as would have been understood by one of ordinary skill.

With respect to claim 15, Nakamura discloses the zoom (22) includes an optical system in each of the pair of main stereoscopic observation beam paths (fig. 3).

With respect to claim 16, Nakamura discloses the axis of the zoom (22) extends substantially perpendicular to the optical axis (K1) of the main objective (21) (par. 44).

With respect to claim 17, Nakamura discloses the assistant's microscope (26) is mechanically detachable from the main microscope (1) (par. 15).

With respect to claim 18, Nakamura discloses the beam splitter (B1) is mechanically detachable from the main microscope (1) together with the assistant's microscope (26) (fig. 2).

With respect to claim 19, Nakamura discloses the assistant's microscope (26) includes a deflection element (27) for receiving the pair of assistant's stereoscopic observation beam paths along an assistant's microscope axis (K4) and redirecting the pair of assistant's stereoscopic observation beam paths into an assistant's binocular tube (19) (fig. 2).

With respect to claim 20, Nakamura discloses the assistant's microscope (26) further includes optical components in the assistant's microscope axis (K4) between the beam splitter (B1) and the deflection element (27), the optical components (IR) providing an image rotation between the beam splitter and the deflection element (figs. 5-7).

With respect to claim 21, Nakamura discloses the deflection element (27) is rotatable relative to the beam splitter (B1) about the assistant's microscope axis (K4) (par. 41).

With respect to claim 22, Nakamura suggests the rotation of the beam splitter (B1) together with the assistant's microscope (26) is drivable in motorized or manual fashion.

With respect to claim 23, Nakamura discloses deflection element (27) is rotatable relative to the beam splitter (B1) to vary a tilt angle between the assistant's microscope axis (K4) and the direction of the pair of assistant's stereoscopic observation beam paths after redirection by the deflection element (27) (fig. 5).

With respect to claim 24, Nakamura suggest the main objective (21) has a fixed focal length (i.e. when the lenses L2 are not moved).

With respect to claim 25, Nakamura suggests the main objective (21) has a variable focal length (par. 32).

With respect to claim 26, Nakamura does not expressly an illumination beam path directed through the main objective. However, it is well known in the art that illumination beams may be directed through the main objective of a microscope. For example, Biber teaches such an arrangement (figs. 1a-3b). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to provide an illumination beam path directed through the main objective as an alternative to the arrangement of Nakamura so that the objective lenses may be used to focus the illumination beam on the subject thereby eliminating the need for additional focusing lenses.

With respect to claim 27, Nakamura discloses the main objective (21) is divided into at least two parts (par. 32).

With respect to claim 28, the combination of Nakamura and Biber suggests a first part (L2) of the main objective is used for the main observation beam paths of the main microscope, and a second part (M1) of the main objective is used for the illumination beam path, the second

part being spaced from the first part and arranged at an angle to the optical axis (Nakamura figs. 2-3).

With respect to claim 29, Nakamura does not expressly disclose the main objective is rotatable, together with the illumination beam path, about the optical axis of the main objective. However, Biber teaches such an arrangement may be desirable (col. 4, lines 1-4). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to allow the main objective to be rotatable, together with the illumination beam path, about the optical axis of the main objective so that the illumination system can be incorporated into the main body housing the objective.

(10) Response to Argument

A. Claims 14-22, 24-27, and 29

In response to appellant's argument that the Nakamura reference teaches away from the proposed combination, though the examiner recognizes that a prior art reference must be considered in its entirety, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See also MPEP § 2123. It is important to recognize that the prior art must not be read in a vacuum, but in light of the knowledge of one of ordinary skill. "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33,

216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

Nakamura teaches the desirability of *independent magnification adjustment* not necessarily the desirability of separate/multiple objectives. This feature of independent magnification adjustment is not negated by the use of a single objective (or, more specifically, the proposed combination). For example, fig. 5A of Tanaka (US 4,640,588) teaches a similar stereomicroscope with independent zoom systems after a main objective and beam splitter. Thus, the proposed combination does not preclude independent magnification adjustment as the Appellant has alleged.

Likewise, though Nakamura teaches the desirability of a detachable assistant's microscope, this feature is not precluded by the proposed combination. See, for example, Howes (US 5,528,426) or Kleinberg (US 5,052,789) or Corbisiero et al. (US 6,421,173) or Minami et al. (US 4,763,968) in which each teach modular/detachable assistant microscopes. As can be seen from these references, locating the beam splitter between the objective and magnification system would not alone prohibit the assistant's microscope from being detachable.

Further, the omission of an element and its function is obvious if the function of the element is not required. See *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). Hence, it does not follow that the elimination of some advantage taught by a reference constitutes a "teaching away" as the Appellant has

suggested. Even if one of ordinary skill in the art would have combined the art such that the advantages of Nakamura or Biber were eliminated, such a combination does not promote non-obviousness. Otherwise, one could never make an “obvious” modification to select one known advantage over another. Note, for example, Littmann (DE 1 217 099) which teaches stereomicroscopes with independent objectives (fig. 1) may, alternatively, be arranged with a common objective (figs. 2-7) thereby simplifying the arrangement.

Further still, in response to appellant’s argument that the proposed combination is a more challenging design feature, it is noted that the question of the difficulty of creating the proposed combination only pertains to the question of the level of one of ordinary skill in the art. Again, the proposed combination does not require the arrangement that the Appellant alleges. The assistant’s microscope could be attached along with the objective lens to the main microscope, thus allowing “easy” assembly. Also, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Not only would one of ordinary skill recognize that this feature (i.e. attachment of the assistant microscope at the bottom of the main microscope body) is an optional alternative to other prior art teachings, modifying a microscope for attachment of the assistant microscope at several locations was known in the art at the time of the invention. For example, Howes (US 5,528,426) and Kleinberg (US 5,052,789) and Corbisiero et al. (US 6,421,173) and Minami et al. (US 4,763,968) each teaches such a detachable arrangement. Thus, the level of difficulty of

achieving the proposed combination is not germane to patentability since it could have been achieved by one of ordinary skill in the art.

B. Claim 23

In response to appellant's argument that the Nakamura reference fail to show certain features of claim 23, it is noted that the features upon which applicant relies (i.e., the light flux passing through the beam splitter) is not specifically claimed. Nonetheless, Nakamura does teach such an arrangement in fig. 5. As evident from par. 43, Nakamura discloses a branching unit H may be a beam splitter to direct the light to the assistant's microscope.

C. Claim 28

In response to appellant's argument that the proposed combination does not meet the limitations of amended claim 28 drawn to two objective parts, it is noted that the only support for the new limitations can be found in fig. 1 of the appellant's specification where the "first part" refers to element 2 and the "second part" refers to element 13. Applicant does not appear to have support according to 35 USC 112, 1st paragraph for any alternative interpretations. Further, it is noted that the proposed combination does not require or preclude a two-part objective as applicant suggests. It only indicates that a possible advantage to the combination is that separate objectives would not be required (though a single objective may still be composed of multiple lenses or parts). Further, the illumination system/objective arrangement of Nakamura (shown in fig. 2) appears to be substantially identical to that of the appellant's (shown in fig. 1). Where the claimed and prior art products are identical or substantially identical in structure, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the

products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Mark Consilvio/

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